IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application. No.	: 10/725,623	Confirmation No.	: 4992
1st Named Inventor	: Kamrava	Art Unit	: 3772
Filed	: December 1, 2003	Examiner	: Nguyen, Camtu Tran
Docket No.	: 5603.P001X2		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF
IN SUPPORT OF APPELLANT'S APPEAL
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Sir:

This Reply Brief is in furtherance of the Appeal Brief, filed in the above-captioned case on June 24, 2010. Applicants (hereafter "Appellants") hereby submit this Reply Brief (37 C.F.R. § 41.41). Appellants respectfully request consideration of this appeal by the Board of Patent Appeals and Interferences for allowance of the above-captioned patent application.

An oral hearing is not desired.

ARGUMENT (37 C.F.R. § 41.37(c)(1)(vii))

A. THE OBJECTION TO THE DRAWINGS UNDER 37 CFR 1.83(A) AS ALLEGEDLY FAILING TO SHOW THE ANGLE γ IS BELIEVED TO BE IMPROPER.

Appellants respectfully submit that the objection to the drawings is improper. The angle γ is shown in the replacement FIG. 3 submitted along with the Response submitted by Appellants on February 19, 2008 in response to the Final Office Action that was mailed October 30, 2007. As discussed in that Response, FIG. 3 was amended to include the angle γ. The replacement FIG. 3 was not objected to or disapproved by the Examiner. Accordingly, the objection is believed to be inappropriate.

B. REJECTION OF CLAIMS 30 AND 33 UNDER 35 U.S.C. §101, BECAUSE THE CLAIMED INVENTION IS ALLEGEDLY DIRECTED TO NON-STATUTORY SUBJECT MATTER IS BELIEVED TO BE IMPROPER.

GROUP 1: CLAIMS 30 AND 33

Appellants respectfully submit that claims 30 and 33 are directed to statutory subject matter. Claim 30 recites "*The catheter of claim 1, further comprising an embryo in the distal portion.*" Accordingly, claim 30 does not claim the embryo, but rather claims the "***catheter of claim 1***" having the embryo in the distal portion. An embryo itself is not being claimed, but rather a catheter having an embryo. The catheter of claim 1 is statutory subject matter. Accordingly, the catheter of claim 30 which further defines the catheter of claim 1 is also statutory subject matter. Moreover, as claimed, the embryo in the catheter is a **non-naturally occurring** combination (e.g., outside the human body), which does not occur in nature, but rather which is the product of human ingenuity. Additionally, the Examiner's rejection is **not sufficiently articulated**. The Examiner has on the top of page 4 of the Examiner's Answer only stated "*When claim(s) recite(s) a device/apparatus with elements being "attached to" subject*

matter that is naturally occurring in nature, such recitation makes the claim(s) non-statutory." Applicants respectfully submit that this reasoning is simply flawed and therefore the rejection is **not sufficiently articulated**. This reasoning would mean that **water, soil, wood, air, natural gas, petroleum**, **graphite,** and other matter naturally occurring in nature could not be attached to an apparatus of a claim. This, of course, is not the case. Accordingly, for at least one of these reasons, the rejection of the claims of Group 1 is believed to be improper.

C. REJECTION OF CLAIMS 1, 11, 28 & 32 UNDER 35 U.S.C. 112, FIRST PARAGRAPH, AS ALLEGEDLY FAILING TO COMPLY WITH THE WRITTEN DESCRIPTION REQUIREMENT IS BELIEVED TO BE IMPROPER.

Applicants respectfully submit that the Examiner has withdrawn this rejection. On the middle of page 8 of the Examiner's Answer, the Examiner has stated "*Regarding the 112 rejections, these rejected are withdrawn in view of appellant's comments.*"

D. THE REJECTION OF CLAIMS 1-18, AND 26-34 UNDER 35 U.S.C. §103(a) AS ALLEGEDLY BEING UNPATENTABLE OVER U.S. PATENT NO. 4,474,576 TO GOBBY (HEREINAFTER "GOBBY") IN VIEW OF U.S. PATENT NO. 5,472,419 TO BACICH (HEREINAFTER "BACICH") IS BELIEVED TO BE IMPROPER.

GROUP 4: CLAIMS 1-10, 18, AND 30

Without admitting that these references could or should be combined, Appellants respectfully submit that the claims of Group 4 are allowable over Gobby and Bacich.

Claim 1 recites:

"*A catheter comprising:*

a shaft comprising a body with a proximal portion and a distal portion, the body having a length configured for placement through an endoscopic device in an assisted embryo transfer procedure and the body defining an opening from the proximal portion to the distal portion, the distal portion having an exterior dimension suitable for insertion into a body of a subject as a procedural instrument for transferring an embryo, the distal portion having ***an end that is beveled*** *in a first direction* ***across the opening****, such that a length of the shaft to a first point on the end is a first length and a length of the shaft to a* ***second point on the end*** *is a second length longer than the first length,* ***a portion of the shaft including the second point is beveled in a second direction opposite the first direction defining a tip shaped to be inserted into an endometrial lining of the subject****, and wherein* ***the tip comprises a material that has sufficient rigidity to penetrate the endometrial lining of the subject and sufficient flexibility to resist penetration of a uterine muscle of the subject.***"

Appellants respectfully submit that Gobby and Bacich do not disclose these limitations or render them obvious.

Gobby discusses in part an apparatus for artificial insemination. See e.g., the Title. As discussed in part in the Abstract, the apparatus includes a locating tube that is adapted to be inserted into the vagina, and one end of the tube located against the cervix of the uterus around the cervical canal. A delivery member is adapted to be passed along the locating tube and into the uterus for delivery of semen into the uterus.

canal. A delivery member is adapted to be passed along the locating tube and into the uterus for delivery of semen into the uterus.

Bacich discusses in part a catheter and method for depositing reproductive material into the reproductive tract of a female. See e.g., the Title.

However, Appellants respectfully submit that Gobby and Bacich does not disclose or render obvious the limitations of claim 1.

Firstly, Gobby and Bacich do not disclose or render obvious that "*a portion of the shaft including the second point is beveled in a second direction opposite the first direction* ***defining a tip shaped to be inserted into an endometrial lining of the subject.***"

The Examiner has already acknowledged that the "*Gobby device does not disclose the distal passage portion of the delivery section (51) is beveled*". See e.g., the middle of page 6 of the present Final Office Action mailed 11/24/2009.

Bacich does not remedy what is missing from Gobby. The Examiner appears to have relied upon FIG. 2 of Bacich to reject the claimed "*a portion of the shaft including the second point is beveled in a second direction opposite the first direction* ***defining a tip shaped to be inserted into an endometrial lining of the subject.***" See e.g., the bottom of page 6 through the top of page 7 of the present Final Office Action. The Examiner has provided the following marked-up FIG. 2 of Bacich (see bottom of page 6 of Final Office Action):

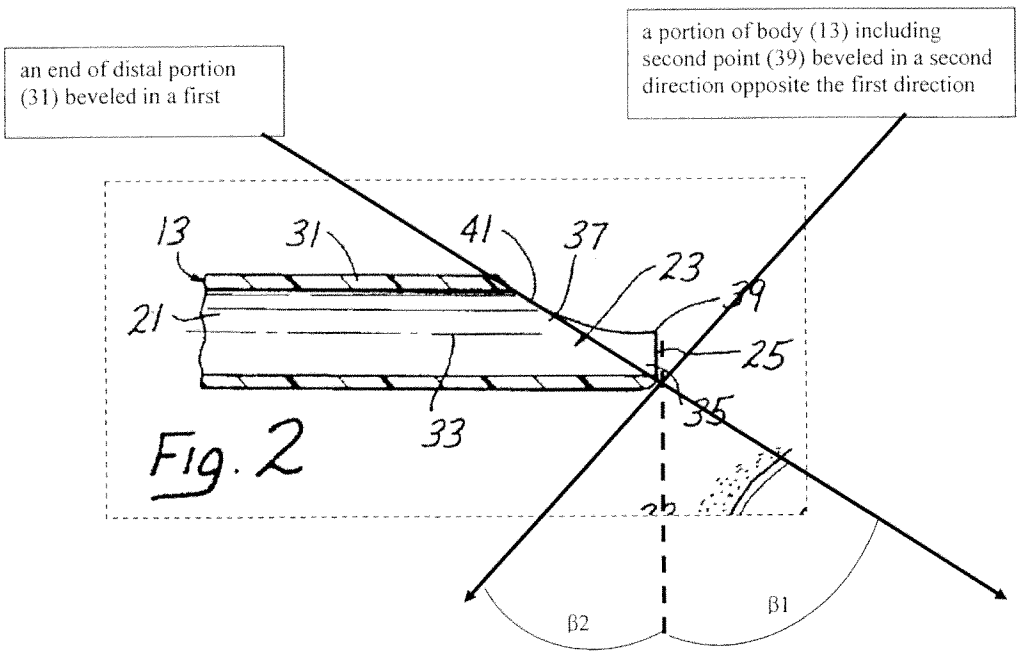
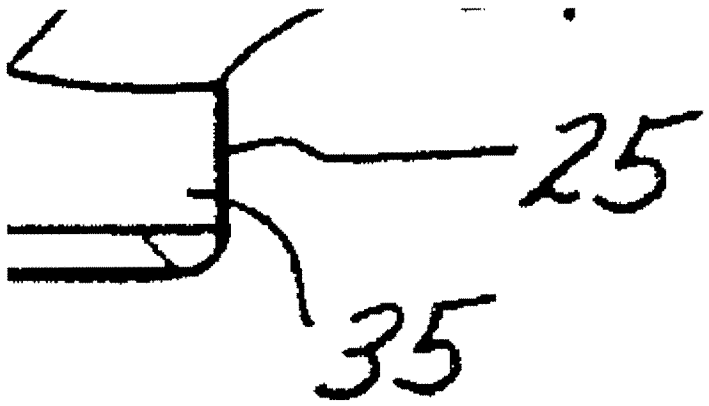


Fig. 2

The Examiner's markup somewhat obscures the Figure. A zoomed in but unmodified portion of FIG. 2 of Bacich shows the following:



As can be clearly seein, the unmodified FIG. 2 of Bacich shows that the surface relied upon by the Examiner is **rounded** and that there is no "***tip shaped to be inserted into an endometrial lining of the subject.***" A rounded surface does not meet the limitations recited in claim 1 of "*a portion of the shaft including the second point is beveled in a second direction opposite the first direction* ***defining a tip shaped to be inserted into an endometrial lining of the subject.***"

In fact, Bacich appears to **teach away** from a tip shaped to be inserted into tissue of a subject. At column 2, lines 26-38, Bacich states "*To reduce the likelihood of trauma, the distal end of the transfer catheter is* ***preferably substantially blunt*** *(emphasis added).*" Similarly, at column 4, line 54, Bacich states "*The distal end 25 is* ***blunt*** *(emphasis added).*" FIGs. 2 and 6 of Bacich clearly show **rounded** corners, apparently to make them more blunt. FIGs. 4, 5, 8, and 12 of Bacich clearly show that the catheter is **not** intended to be inserted into the tissue. **FIG. 5 of Bacich clearly shows that the rounded surface rests against the tissue but is not inserted into the tissue. The device of Bacich simply is not designed to be inserted into the tissue, and is in fact actually designed to prevent insertion into the tissue**. Bacich does not disclose that the catheter is to be **inserted** into the tissue, or designed for this purpose, and in fact Bacich specifically designs the catheter to be **blunt** so that it is **not inserted** into the tissue. Accordingly, Bacich does not disclose or render obvious "*a portion of the shaft including the second point is beveled in a second direction opposite the first direction* ***defining a tip shaped to be inserted into an endometrial lining of the subject***".

Moreover, it is inappropriate for the Examiner to merely disregard these limitations on the belief that they are functional. These limitations are **structural** limitations that define the **shape** of the tip. Moreover, these limitations are not appropriately rejected based on Bacich because these limitations are not "***inherent*** *(emphasis added)*" in the catheters of Bacich. See e.g., MPEP Section 2114. In the instant case, claim 1 recites that "*a portion of the shaft including the second point is beveled in a second direction opposite the first direction* ***defining a tip shaped to be inserted into an endometrial lining of the subject.***" These limitations are not **inherent** in the catheters of Bacich. As discussed above, Bacich explicitly teaches that "*the distal end of the transfer catheter is* ***preferably substantially blunt*** *(emphasis added)*" to reduce tissue damage.

Accordingly, for at least this first set of reasons, the claims of Group 4 are believed to be allowable over Gobby and Bacich.

Secondly, Gobby and Bacich do not disclose or render obvious that "*the distal portion having* ***an end that is beveled*** *in a first direction* ***across the opening****, such that a length of the shaft to a first point on the end is a first length and a length of the shaft to a* ***second point on the end*** *is a second length longer than the first length,* ***a portion of the shaft including the second point is beveled in a second direction opposite the first direction*** *defining* ***a tip***."

These claim limitations make it clear that **the second point is "*on the end*" which is beveled "*across the opening.*"** However, the location in the Bacich FIG. 2 which the Examiner relies upon to reject the beveling in the second direction opposite the first direction (namely the lower right side rounded corner in FIG. 2 of Bacich) is not **on an end which is beveled across the opening**.

As disclosed in the present patent application, a catheter according to an embodiment may be used to deliver an embryo within a flap in an endometrial lining. As plainly shown in FIG. 11 of the present application, and as discussed in paragraph [0029], "*A point at the distal end of shaft 25 representing the greatest length of shaft 25 defines tip 35. A portion of the body of shaft 25 including tip 35 may be beveled in a direction opposite bevel angle γ to yield a more refined cutting tool.*" As recited in claim 1, the second point is on "***an end that is beveled*** *in a first direction* ***across the opening***" and also "***a portion of the shaft including the second point is beveled in a second direction opposite the first direction*** *defining* ***a tip***." In contrast, the location of the second bevel relied upon by the Examiner is not on "***an end that is beveled*** *in a first direction* ***across the opening.***"

Accordingly, for at least this second set of reasons, the claims of Group 4 are believed to be allowable over Gobby and Bacich.

Thirdly, Gobby and Bacich do not disclose or render obvious that "*the tip comprises* ***a material that has sufficient rigidity to penetrate the endometrial lining of the subject and sufficient flexibility to resist penetration of a uterine muscle of the subject***".

Neither Gobby or Bacich discloses that the apparatus or catheter is to penetrate the endometrial lining, let alone that the apparatus or catheter includes a tip comprising a material having the claimed rigidity and flexibility characteristics.

In the rejection, the Examiner appears to rely on the argument that Bacich teaches that polytetrafluoroethylene or other material may be used. However, the Examiner is assuming, without sufficient basis, that the polytetrafluoroethylene or other material of Bacich would have the claimed rigidity and flexibility characteristics as recited in claim 1. It is well known that the rigidity and flexibility characteristics of a plastic depend upon a number of factors in addition to the plastic type, such as, for example, **molecular weight, density, formation conditions, thickness, etc.** Neither Gobby or Bacich mention that the apparatus or catheter is to penetrate the endometrial lining and resist penetrating the uterine muscle. Since the devices in Bacich are not used or designed for this purpose, it is inappropriate for the Examiner to assume that the polytetrafluoroethylene in Bacich would have sufficient rigidity to penetrate the endometrial lining of the subject and sufficient flexibility to resist penetration of a uterine muscle of the subject. The Examiner has not established that these characteristics would be inherent to Bacich. At the very least, the material in Bacich appears to **significantly thick at the far distal end** which would certainly increase its ridgidity. **A materials ridgidity depends strongly on its thickness**. As understood by Appellants, since Bacich doesn't disclose that it would be desirable to make the catheters flexible, there is no reason to assume that they would be flexible. Rather, it is more reasonable to assume that they would be made rigid **so that they don't bend when they aren't intended to bend**, or so that they are more durable, last longer, and are less susceptible to breaking, etc. Since there is no desire in Bacich to make the devices in Bacich flexible, and since they are seemingly so thick that they would not be flexible, it is inappropriate for the Examiner to assume that they have the claimed flexibility. Moreover, Bacich also discloses at column 4, lines 26-28 that "*The adapter 15, which may be constructed for example of* ***stainless steel,*** *polytetrafluoroethylene, polyethylene or other biocompatible polymer (emphasis added).*" The fact

that **stainless steel** may be substituted for by polytetrafluoroethylene and biocompatible polymer also seems to suggest that it is desirable to make the catheters **rigid** rather than as flexible as claimed.

Accordingly, for at least this third set of reasons, the claims of Group 4 are believed to be allowable over Gobby and Bacich.

GROUP 5: CLAIMS 11, 12-17, AND 33

Without admitting that these references could or should be combined, Appellants respectfully submit that the claims of Group 5 are allowable over Gobby and Bacich.

Claim 11 recites:

"*An apparatus comprising:*

a catheter body with a proximal portion and a distal portion and having a length configured for placement through an endoscopic device in an assisted embryo transfer procedure, the distal portion having ***an angled tip*** *and an outside diameter suitable for insertion into a body of a subject as a procedural instrument, wherein* ***the angled tip has a shape that is suitable for insertion into an endometrial lining*** *of the subject and comprises a material that has* ***sufficient rigidity*** *to penetrate the endometrial lining of the subject and* ***sufficient flexibility*** *to resist penetration of a uterine muscle of the subject;*

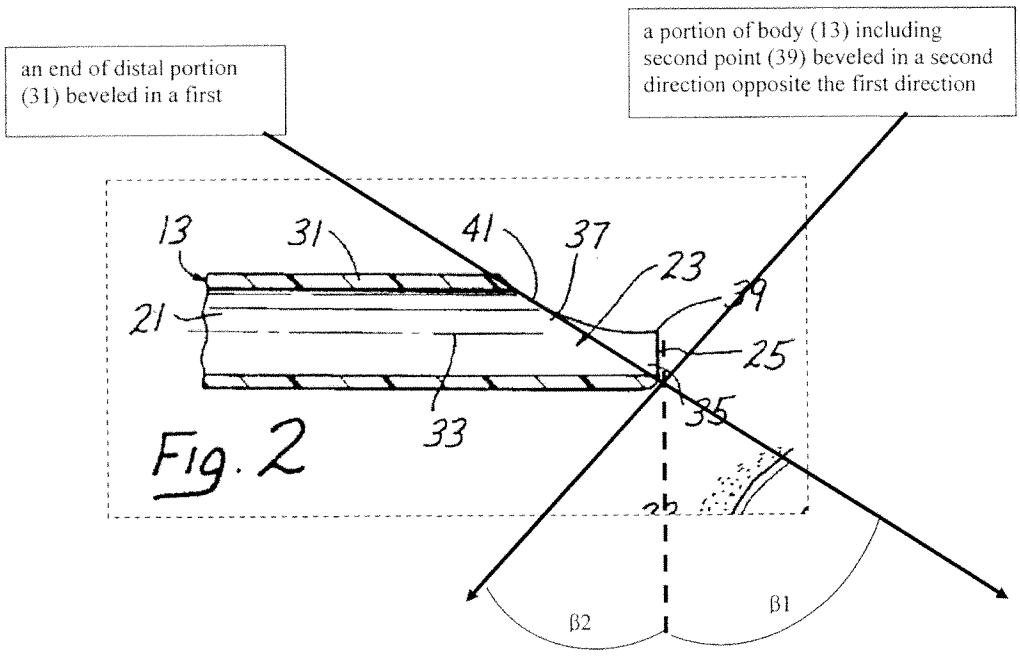
the distal portion of the catheter body having ***an end beveled in a first direction across an end opening and a portion beveled in a second direction opposite the first direction defining the angled tip****; and*

a portion of the distal portion having a fixed axis different than an axis of the proximal portion."

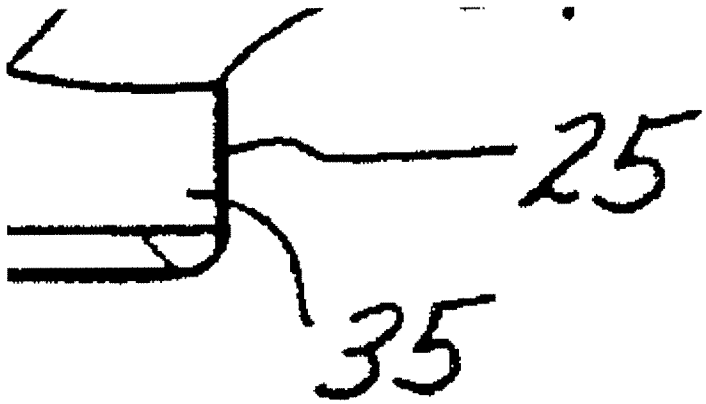
Appellants respectfully submit that Gobby and Bacich do not disclose these limitations or render them obvious.

Firstly, Gobby and Bacich do not disclose or render obvious that "*the distal portion having* ***an angled tip***."

The Examiner appears to have relied upon FIG. 2 of Bacich to reject the claimed "***angled tip.***" As discussed above, the Examiner has provided the following marked-up FIG. 2 of Bacich (see bottom of page 6 of Final Office Action):



The Examiner's markup somewhat obscures the Figure. A zoomed in but unmodified portion of FIG. 2 of Bacich shows the following:



As can be clearly seen, the unmodified FIG. 2 of Bacich shows that the surface relied upon by the Examiner is **rounded** and that there is no "***angled tip.***" The rounded surface in Bacich does not meet the limitations recited in claim 1 of the recited "***angled tip.***"

Accordingly, for at least this first set of reasons, the claims of Group 5 are believed to be allowable over Gobby and Bacich.

Secondly, Gobby and Bacich do not disclose or render obvious that "***the angled tip has a shape that is suitable for insertion into an endometrial lining*** *of the subject.*"

The Examiner appears to have relied upon Bacich to reject these limitations. See e.g., the bottom of page 6 through the top of page 7 of the present Final Office Action.

However, as discussed above in conjunction with claim 1, Bacich shows that the surface relied upon by the Examiner is **rounded** and that there is no **angled** tip having "***a shape that is suitable for insertion into an endometrial lining of the subject.***" In fact, Bacich appears to **teach away** from a tip shaped to be inserted into tissue of a subject. At column 2, lines 26-38, Bacich states "*To reduce the likelihood of trauma, the distal end of the transfer catheter is* ***preferably substantially blunt*** *(emphasis added).*" Similarly, at column 4, line 54, Bacich states "*The distal end 25 is* ***blunt*** *(emphasis added).*" FIGs. 2 and 6 of Bacich clearly show **rounded** corners, apparently to make them more blunt. FIGs. 4, 5, 8, and 12 of Bacich clearly show that the catheter is **not** intended to be inserted into the tissue. Bacich does not disclose that the catheter is to be **inserted** into the tissue, or designed for this purpose, and in fact Bacich specifically designs the catheter to be **blunt** so that it is **not inserted** into the tissue. Accordingly, Bacich does not disclose or render obvious "***the angled tip has a shape that is suitable for insertion into an endometrial lining*** *of the subject.*"

Moreover, it is inappropriate for the Examiner to merely disregard these limitations on the belief that they are functional. These limitations are **structural** limitations that define the **shape** of the angled tip. Moreover, these limitations are not appropriately rejected based on Bacich because these limitations are not "***inherent*** *(emphasis added)*" in the catheters of Bacich. See e.g., MPEP Section 2114. In the instant case, claim 1 recites that "***the angled tip has a shape that is suitable for insertion into an endometrial lining*** *of the subject.*" These limitations are not **inherent** in the

catheters of Bacich. As discussed above, Bacich explicitly teaches that "*the distal end of the transfer catheter is* ***preferably substantially blunt*** *(emphasis added)*" to reduce tissue damage.

Accordingly, for at least this second set of reasons, the claims of Group 5 are believed to be allowable over Gobby and Bacich.

Thirdly, Gobby and Bacich do not disclose or render obvious that "*the distal portion of the catheter body having* ***an end beveled in a first direction across an end opening and a portion beveled in a second direction opposite the first direction defining the angled tip***."

These limitations make it clear that **the angled tip is defined by the beveling in the first direction across the end opening and the beveling in the second direction opposite the first direction**. However, the location in the Bacich FIG. 2 which the Examiner relies upon to reject the beveling in the second direction opposite the first direction (namely the lower right side rounded corner in FIG. 2 of Bacich) is **separate** from the beveling in the first direction across the end opening. What the Examiner relies upon for the tip is **separate** from the beveling across the end opening. Therefore, Bacich does not have an angled tip defined by the beveling in the first direction across the end opening and the beveling in the second direction opposite the first direction.

Accordingly, for at least this third set of reasons, the claims of Group 5 are believed to be allowable over Gobby and Bacich.

Fourthly, Gobby and Bacich do not disclose or render obvious that the tip has "*a material that has* ***sufficient rigidity*** *to penetrate the endometrial lining of the subject and* ***sufficient flexibility*** *to resist penetration of a uterine muscle of the subject*".

Neither Gobby or Bacich discloses that the apparatus or catheter is to penetrate the endometrial lining, let alone that the apparatus or catheter includes a tip comprising a material having the claimed rigidity and flexibility characteristics.

In the rejection, the Examiner appears to rely on the argument that Bacich teaches that polytetrafluoroethylene or other material may be used. However, the Examiner is assuming, without sufficient basis, that the polytetrafluoroethylene or other material of Bacich would have the claimed rigidity and flexibility characteristics as recited in claim 1. It is well known that the rigidity and flexibility characteristics of a plastic depend upon a number of factors in addition to the plastic type, such as, for example, **molecular weight, density, formation conditions, thickness**, etc. Neither Gobby or Bacich mention that the apparatus or catheter is to penetrate the endometrial lining and resist penetrating the uterine muscle. Since the devices in Bacich are not used or designed for this purpose, it is inappropriate for the Examiner to assume that the polytetrafluoroethylene in Bacich would have sufficient rigidity to penetrate the endometrial lining of the subject and sufficient flexibility to resist penetration of a uterine muscle of the subject. At the very least, the material in Bacich appears to **significantly thicker at the far distal end** which would certainly increase its ridgidity. As understood by Appellants, since Bacich doesn't disclose that it would be desirable to make the catheters flexible, there is no reason to assume that they would be flexible. Rather, it is more reasonable to assume that they would be made rigid so that they don't bend when they aren't intended to bend, or so that they are more durable, last longer, and are less susceptible to breaking, etc. Moreover, Bacich also discloses at column 4, lines 26-28 that "*The adapter 15, which may be constructed for example of* ***stainless steel,*** *polytetrafluoroethylene, polyethylene or other biocompatible polymer (emphasis added).*" The fact that **stainless steel** may be substituted for by polytetrafluoroethylene and biocompatible polymer also seems to suggest that it is desirable to make the catheters **rigid** rather than as flexible as claimed.

Accordingly, for at least this fourth set of reasons, the claims of Group 5 are believed to be allowable over Gobby and Bacich.

GROUP 6: CLAIM 34

Without admitting that these references could or should be combined, Appellants respectfully submit that the claims of Group 6 are allowable over Gobby and Bacich.

Claim 34 recites:

"*An apparatus comprising:*

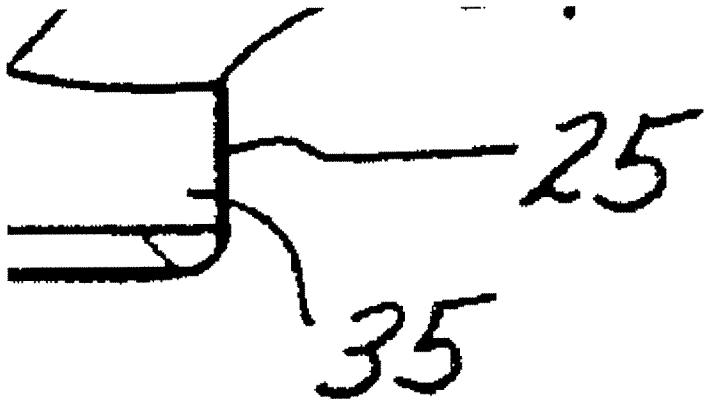
a catheter body having a proximal portion and a distal portion and an opening from the proximal portion to the distal portion, wherein the distal portion has an outside diameter suitable for insertion into a uterus; and

a ***microsurgical instrument*** *at the distal portion, the* ***microsurgical instrument*** *including an end of the distal portion that is* ***beveled across the opening to form an angled tip****, the* ***angled tip shaped for insertion into an endometrial lining.***"

Appellants respectfully submit that Gobby and Bacich do not disclose these limitations or render them obvious.

Firstly, Gobby and Bacich do not disclose or render obvious that "*the distal portion having* ***an angled tip***."

The Examiner appears to have relied upon FIG. 2 of Bacich to reject the claimed "***angled tip.***" As discussed above, the zoomed in but unmodified portion of FIG. 2 of Bacich shows the following:



As can be clearly seen, the unmodified FIG. 2 of Bacich shows that the surface relied upon by the Examiner is **rounded** and that there is no "***angled tip.***" The rounded surface in Bacich does not meet the limitations recited in claim 1 of the recited "***angled tip.***"

Accordingly, for at least this first set of reasons, the claims of Group 6 are believed to be allowable over Gobby and Bacich.

Secondly, Gobby and Bacich do not disclose or render obvious a "***microsurgical instrument including ... an angled tip, the angled tip shaped for insertion into an endometrial lining***."

Neither Gobby and Bacich teach or suggest that their apparatus are **microsurgical** instruments, let alone that they have **an angled tip shaped for insertion into an endometrial lining**. As discussed above in conjunction with claim 1, Bacich shows that the surface relied upon by the Examiner is **rounded** and that there is no angled tip having "***a shape that is suitable for insertion into an endometrial lining of the subject.***" In fact, Bacich appears to **teach away** from a tip shaped to be inserted into tissue of a subject. At column 2, lines 26-38, Bacich states "*To reduce the likelihood of trauma, the distal end of the transfer catheter is* ***preferably substantially blunt*** *(emphasis added).*" Similarly, at column 4, line 54, Bacich states "*The distal end 25 is* ***blunt*** *(emphasis added).*" FIGs. 2 and 6 of Bacich clearly show **rounded** corners, apparently to make them more blunt. FIGs. 4, 5, 8, and 12 of Bacich clearly show that the catheter is **not** intended to be **inserted** into the tissue. Bacich does not disclose that the catheter is to be **inserted** into the tissue, or designed for this purpose, and in fact Bacich specifically designs the catheter to be **blunt** so that it is **not inserted** into the tissue. Accordingly, Bacich does not disclose or render obvious a "***microsurgical instrument including ... an angled tip, the angled tip shaped for insertion into an endometrial lining***."

Moreover, it is inappropriate for the Examiner to merely disregard these limitations on the belief that they are functional. These limitations are **structural** limitations that define the **shape** of

the angled tip. Moreover, these limitations are not appropriately rejected based on Bacich because these limitations are not "***inherent*** *(emphasis added)*" in the catheters of Bacich. See e.g., MPEP Section 2114. In the instant case, claim 34 recites that "***the angled tip shaped for insertion into an endometrial lining***." These limitations are not **inherent** in the catheters of Bacich. As discussed above, Bacich explicitly teaches that "*the distal end of the transfer catheter is* ***preferably substantially blunt*** *(emphasis added)*" to reduce tissue damage.

Accordingly, for at least this second set of reasons, the claims of Group 6 are believed to be allowable over Gobby and Bacich.

Thirdly, Gobby and Bacich do not disclose or render obvious that "*an end of the distal portion that is* ***beveled across the opening to form an angled tip***."

These limitations make it clear that the beveling across the opening **forms** the angled tip. However, the location in the Bacich FIG. 2 which the Examiner relies upon to reject the tip (namely the lower right side rounded corner in FIG. 2 of Bacich) is **separate** from the beveling across the opening in Bacich. Accordingly, in Bacich the beveling across the opening does not **form** the angled tip. Accordingly, Bacich do not disclose or render obvious that "*an end of the distal portion that is* ***beveled across the opening to form an angled tip***."

Accordingly, for at least this third set of reasons, the claims of Group 6 are believed to be allowable over Gobby and Bacich.

GROUP 7: CLAIMS 26, 27, 31

Claim 27 recites "*wherein the* ***tip is pointed***." Gobby and Bacich do not disclose these limitations or render them obvious. The Examiner appears to have relied upon Bacich to reject the **tip**. However, as discussed above in conjunction with claim 1, for example, the portion of FIG. 2 of Bacich relied upon by the Examiner to reject the tip is **rounded**, not **pointed**. Gobby does not disclose a tip meeting the other requirements of the tip in claim 1, which is why the Examiner has

not relied upon Gobby to reject the claimed tip in claim 1. In Gobby the device is shown from a zoomed out perspective and the device is so long that the distal end looks small, but it is not a pointed tip. In Gobby, the manipulations discussed at column 4, lines 10-15 of Gobby would seem to cause unwanted damage to the tissue if the tip was pointed. Moreover, there would be no intention in Gobby to deliver semen under the tissue, and therefore no need or want for a pointed tip. Accordingly, for at least this third set of reasons, the claims of Group 7 are believed to be allowable over Gobby and Bacich.

GROUP 8: CLAIM 28 AND 32

Claim 32 recites "*the tip comprises* ***a cutting tool capable of being inserted into the endometrial lining***." Gobby and Bacich do not disclose these limitations or render them obvious. Neither Gobby and Bacich teach or suggest that their devices have a tip that comprises **a cutting tool**. The Examiner appears to have relied upon Bacich to reject the **tip**. However, Bacich does not teach or suggest that a tip of the catheter have a cutting tool. In fact, Bacich seems to teach away from cutting tissue. The discussion above in conjunction with claim 11 is generally pertinent to this point, but for brevity won't be repeated. Gobby does not disclose a tip meeting the other requirements of the tip in claim 11, which is why the Examiner has not relied upon Gobby to reject the claimed tip in claim 11. Moreover, in Gobby the device is for "*delivery of a charge of semen to the uterous*" (column 1, lines 10-11), Gobby does not disclose that it would be desirable to **deliver the semen under the tissue**, and therefore the tip is not a cutting tool capable of being inserted into the endometrial lining. Accordingly, for at least this third set of reasons, the claims of Group 8 are believed to be allowable over Gobby and Bacich.

GROUP 9: CLAIM 29

Claim 29 recites "*the distal portion comprises a* ***microsurgical*** *instrument capable of being* ***inserted*** *into the endometrial lining*." Gobby and Bacich do not disclose these limitations or render them obvious. Neither Gobby and Bacich teach or suggest a distal portion that has a **microsurgical**

instrument capable of being inserted into an endometrial lining. Bacich does not teach that the device is a **microsurgical** instrument or that the device is capable of being **inserted** into the endometrial lining. In fact, Bacich teaches that the device should **not** be capable of being inserted into the tissue. Likewise, Gobby does not teach that the device is a **microsurgical** instrument or that the device is capable of being **inserted** into the endometrial lining. Gobby does not disclose that it would be desirable to **deliver the semen under the tissue**. Accordingly, for at least this third set of reasons, the claims of Group 9 are believed to be allowable over Gobby and Bacich.

CONCLUSION

Based on the foregoing, Appellants request that the Board overturn the rejection of all pending claims and hold that all of the claims of the present application are allowable.

Appellants respectfully petition for an extension of time to respond to the outstanding Office Action pursuant to 37 C.F.R. § 1.136(a) should one be necessary. Please charge our Deposit Account No. 02-2666 to cover the necessary fee under 37 C.F.R. § 1.17 for such an extension.

Please charge any shortages and credit any overpayment to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: December 30, 2010

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